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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/717,947 | 11/19/2003 | Leo Shih | OR0324 | 9032 |

22192 7590 09/13/2005

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EXAMINER

GEHMAN, BRYON P

ART UNIT PAPER NUMBER

3728

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/717,947 | SHIH, LEO | |
| | Examiner | Art Unit | |
| | Bryon P. Gehman | 3728 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The request filed on August 18, 2005 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 10/717947 is acceptable and a CPA has been established. An action on the CPA follows.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 8, the relationship between the "specification marking member" inferred to and the previously positively defined "specification marking members" of line 5 is not described and accordingly renders the scope of the claimed tool holder indefinite one has to do with other, or if they are two unrelated structures given the same identification nomenclature, which would also then be indefinite. In line 9, "said specification marking member" lacks antecedent basis, as no single specification marking member is previously positively defined. Plural members are defined, and a single member is inferred, but no particular "specification marking member" is singularly and positively defined.

In claim 2, lines 2-3, "said mark-retaining portion" lacks basis for particularity, as parent claim 1 defines multiple mark-retaining portions, The phraseology should be --each said mark-retaining portion--. In line 4, "said specification marking member"

again lacks antecedent positive recitation of a single member being "said". See also claim 6 for the same problems.

In claim 5, lines 2-3, "said specification marking member" again lacks antecedent positive recitation of a single member being "said".

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art of Figures 1-3 in view of one of Wobber (1,560,009) and Arblaster (3,397,434). The prior art of Figures 1-3 discloses a tool holder comprising a base (as shown), a plurality of holding-and-mark-retaining members (each 12 and 14 in combination) individually mounted on the base, each used to hold and mark a tool and a plurality of specification marking members (at 14), each of the holding-and-mark-retaining members comprising a holding portion (12) and a mark-retaining portion (14), the holding-and-mark-retaining members being slidably movable relative to one another. Wobber and Arblaster each disclose a mark-retaining portion (3; 12; respectively) actually retaining a specification marking member (11; 14) and a retaining means (9 and 10; 22 or 23) for removably retaining the specification marking member in the mark-retaining portion. To modify the tool holder of the prior art of Figures 1-3 employing a

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mark-retaining portion with a removable specification marking member would have been obvious in order to provide interchangeable specification marking members for the same holding-and-mark retaining members, as taught by either one of Wobber and Arblaster.

As to claims 2 and 4, Wobber and Arblaster each disclose a first locating element (area between 9 and 10; 23) provided in an upper face of each mark-retaining portion and a second locating element (underlying edge of 3 engaging 9 or 10; 22) provided in an under face of each specification marking member.

As to claim 3, to reverse the location of the parts of Arblaster would have been an obvious reversal of parts, long held to be an obvious manner of altering an existing structure.

As to claims 5-7, Wobber and Arblaster each disclose the specification marking member (11; 14) slidably received in the mark-retaining portion (3; 12), the retaining portion in the form of a channel.

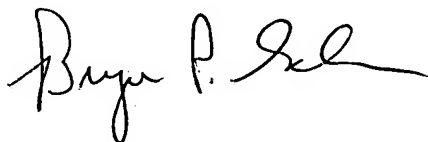
6. Applicant's arguments filed August 18, 2005 have been fully considered but they are not persuasive with respect to the remaining rejections. Applicant's admitted prior art appears to define all of the structure except interchangeable specification marking members, which are shown to have been previously known in the field of indicia by Wobber and Arblaster.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bryon P. Gehman
Primary Examiner
Art Unit 3728



BPG